

REMARKS

Claims 1-2 and 10-35 are pending. Independent claims 1, 12, 16, 20, 24 and 28 were amended as discussed below.

No “new matter” was added in this amendment. The new language wherein the plurality of color blocks are “of different colors” is clearly supported by at least Figs. 2A and 3A. This is an inherent feature of a “color bar” as that term is known in the prior art to which the invention pertains (i.e., the printing arts).

Request for clarification of claims rejected under U.S.C. § 101

In the outstanding Office Action and in the previous Office Action, claims 1, 12, 16, 20, 24 and 28 were rejected as allegedly being directed to non-statutory subject matter. Applicant presumes that all of the pending claims were meant to be rejected, even though the Office Action only lists the independent claims, and have assumed that this is the case for purposes of responding to the Office Action. However, Applicant respectfully requests that the Examiner clarify exactly which claims are being rejected under U.S.C. § 101 so that an appropriate claim drafting strategy can be formulated.

Applicant might be agreeable to incorporate certain dependent claims into the rejected independent claims if such dependent claims are not being rejected under U.S.C. § 101.

Request for Interview Prior to Formal Action on Amendment

Applicant requests an interview prior to formal action on this response. An “Applicant Initiated Interview Request Form” accompanies this response. Please contact Applicant’s undersigned representative to schedule the interview.

Prior Art Rejection

Claims 1, 10-12, 14-16, 18-20, 22-24, 26-28 and 30-35 were rejected under 35 U.S.C.

§ 102(e) as being anticipated by Komori et al. in view of Merz et al. (hereafter, “Komori” and “Merz,” respectively).

Claims 2, 13, 17, 21, 25 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Komori in view of Merz and Chalmers et al.

Applicant respectfully traverses this rejection as it pertains to the amended claims.

1. Komori

Komori discloses a process that can be used when a printing press A becomes unavailable after color proofing is performed using the printing press A, and an alternative printing press B needs be used for the print job without making a new color proof using the printing press B and asking the customer to re-approve the color proof. Komori’s process uses the original color proof made using the printing press A, and performs various adjustments to the printing press B based on colorimeter values obtained from the color proof made using the printing press A.

Figs. 2, 3, 8, 12 and 13 shows printing products printed by a printing press. The printing products 10 shown in Figs. 2, 3 and 8 are similar to conventional proofs used in the printing industry wherein color charts (bars) are printed simultaneously with the proof content, and the color charts (bars) are printed in a marginal region (referred to as a “margin portion” in Komori). In Figs. 2, 3 and 8 of Komori, the color charts are labeled as 3b, 4b and 10b, respectively. The proof content is labeled as 3a, 4a and 10a, respectively. Although Komori does not show the actual proof content, the following text portions of Komori clearly describe that proof content is printed in regions 3a, 4a and 10a (underlining added for emphasis):

a pattern is printed in a region 3a at the center
(lines 2-3 of paragraph [0030])

a pattern is output to a region 4a at the central portion
(lines 1-2 of paragraph [0031])

(Region 10a in Fig. 8 is not explicitly described in Komori, but it is clearly identical in content to regions 3a and 4a of similar Figs. 2 and 3.)

Figs. 2, 3 and 8 thus disclose nothing more than the prior art with respect to color charts (bars) being printed on proofing paper simultaneously with the proof content.

Figs. 12 and 13 of Komori disclose an alternative embodiment wherein no patterns (i.e., proofing content) are printed on the printing products 3, 4, either simultaneously with the color chart (bar) 3b, 4b, or subsequently to the printing of the color chart (bar) 3b, 4b. Only the color chart (bar) 3b, 4b is printed thereon. However, the color chart (bar) 3b, 4c is printed in approximately the center of the printing products 3, 4, instead of being printed in a margin portion as disclosed with respect to Figs. 2, 3 and 8. Paragraphs [0083] through [0085] of Komori describe that colorimeter values are obtained from the color charts (which were printed on printing press A) and are used to set up printing press B.

In sum, Komori discloses two embodiments for printing of a color chart (bar) on a printing proof, as follows:

1. Print the color chart (bar) on a margin portion, simultaneously with the patterns (proofing content). (Figs. 2, 3 and 8)
2. Print the color chart (bar) in approximately the center, without any patterns (proofing content). (Figs. 12 and 13)

2. Merz

Fig. 8 of Merz shows a transparent sheet of image recording media having a code in a form of a colored stripe that contains a pattern of transparent voids. This figure is described on column 5, lines 23-28 as follows:

In FIG. 8, a sheet of image recording media 414 is a transparency. The sheet of image recording media 414 includes a colored stripe 44 that extends along a margin portion of the sheet. The colored stripe 44 contains a pattern of transparent voids 46 spaced apart from one another in a form of a code.

Fig. 8A shows an enlarged view of a portion of the colored stripe 44. Figs. 5, 6 and 9 show other types of codes that are placed on or through the image recording media 414. The purpose of the codes are best illustrated in the flowchart of Fig. 10 which describes that the code is read and then it is determined if the code is compatible with the image forming device. If not, the image recording media 414 (sheet) is rejected. If the code is compatible, then the image recording media 414 (sheet) is accepted and an image is formed on the sheet.

In the outstanding Office Action, the Examiner asserts that the colored stripe 44 in Fig. 8 is a “color bar.” Applicant respectfully traverses this characterization of the colored stripe 44.

A “color bar,” as that term is known in the prior art to which the invention pertains (i.e., the printing arts), and as recited in the current set of claims, has a plurality of color blocks of different colors. No such feature is shown in Merz. The purpose of the color in the colored stripe 44 of Merz is to provide a non-transparent/visible coating on the transparency (sheet of image recording media 414) so that the transparent voids 46 can be distinguished from the otherwise transparent transparency. The adjective “colored” in the context of the phrase “colored stripe” does not mean that the stripe is multi-colored, but only that it is non-transparent/visible. This is further supported by one commonly accepted definition of “colored” which is “having color.”¹

In contrast to Merz, a color bar inherently includes a plurality of color blocks of different colors. While Merz is silent as to what color is used to make the colored stripe, an artisan would understand that it needs to only be one color, and that there would be no reason to make it multi-colored since its purpose as stated above is solely to allow the transparent voids 46 to be distinguished from the otherwise transparent transparency. Nor does Merz describe any other characteristics of the colored stripe that would allow it to be used as a color bar. Stated simply, the colored stripe 44 is completely unsuitable and unusable as a color bar, and no artisan in the field in which this invention pertains would consider the colored stripe 44 to be a color bar.

3. Patentability of amended independent claims 1, 12, 16, 20, 24 and 28 over Komori in view of Merz

i. Komori

Neither of Komori’s two embodiments disclose the currently claimed invention.

Regarding the first embodiment of Komori, the independent claims require (i) a blank region for subsequent printing of a content image portion, (ii) a marginal region outside of the blank region that includes one or more standard color bars pre-printed thereon and having no content image portion, and (iii) that the blank region and the marginal region constitute the entire

¹ colored. Dictionary.com. *Dictionary.com Unabridged*. Random House, Inc. <http://dictionary.reference.com/browse/colored> (accessed: August 12, 2010).

surface area of one side of the sheet of paper. The first embodiment of Komori includes patterns (proofing content) and thus does not disclose the combination of elements (i) and (iii) identified above.

Regarding the second embodiment of Komori, the claims require that the one or more standard color bars extend along a portion of an edge of the sheet of paper and are significantly closer in proximity to the edge of the sheet of paper than an opposing edge of the sheet of paper. In the second embodiment of Komori, the color chart (bar) extends along a center region of the printing product, and thus neither extends along an edge nor is significantly closer in proximity to one edge than an opposing edge. Accordingly, the second embodiment of Komori does not disclose the claimed invention.

Nor is there any reason to move the color chart (bar) in Figs. 12 and 13 of Komori to an edge of the printing product since no patterns (proofing content) are to be printed on the printing product shown in Figs. 12 and 13. Color bars are typically printed near an edge of printing proof, and preferably in the gripper² (and less often in the tail³) so as to maximize the amount of room that is available for the proofing content, as shown in Figs. 2, 3 and 8 of Komori which illustrate conventional proof layouts of color bars and their simultaneously printed proof content. No such need exists with respect to the embodiments in Figs. 12 and 13 because no patterns (i.e., proofing content) are printed on the printing products 3, 4, either simultaneously with the color chart (bar) 3b, 4b, or subsequently to the printing of the color chart (bar) 3b, 4b.

It is well-known in the printing arts that when a color bar is used for color management of a printing press, which is the explicitly stated purpose of Komori, the ideal position on the paper to print the color bar is in a center area of the paper, exactly as shown in Figs. 12 and 13 of Komori. By printing the color bar in the center areas, imperfections in the press setup, such as misregistration of printing plates and/or the printing press, are more easily detected. However, this is usually not done because it typically would interfere with the simultaneous printing of the proof content. Since Komori does not intend to print any proof content in the embodiment shown in Figs. 12 and 13, the color bar can be printed in the more optimal center area. This is

² "gripper" is the area at the edge of a sheet of paper that the printer or copier will use to pull the paper through the machine. This area will not be imaged.

³ "tail" is the area at the opposite edge of the sheet of paper with respect to the gripper.

why Figs. 12 and 13 shows the color bar in the center area of the paper and not near an edge of the printing proof, as shown in Figs. 2, 3 and 8 of Komori which illustrate conventional proof layouts of color bars and simultaneously printed proof content.

Accordingly, it would be contrary to conventional practice in the printing arts to move the color bar in Figs. 12 and 13 of Komori to an edge of the printing product since it would result in a less ideal use of the color bar for color management of the printing press. In the embodiments shown in Figs. 2, 3 and 8, the tradeoff of the less-than-ideal location of the color bar is made so as to maximize the area for printing of the proof content.

Komori thus clearly illustrates that the claimed invention is contrary to conventional wisdom, since the claimed article of manufacture is printed without any proof content, yet the color bar(s) are printed in a marginal region and extends along a portion of an edge of the sheet of paper. This is in clear contrast to the conventional wisdom that color bars are ideally printed in a center area of the paper when no content portion (proof content) appears. Thus, there is no reason why one of ordinary skill would move the color bar in Figs. 12 and 13 of Komori to the edge of the sheet of paper, as recited in the current set of claims.

While the claimed invention also provides color bar(s) in a less-than-ideal location similar to Figs. 2, 3 and 8 of Komori, it is an acceptable tradeoff in providing a sheet of paper that can be subsequently used for printing proof content along with a second color bar, as described in the specification, and claimed in the method claims of corresponding U.S. Patent No. 6,721,068 (Weiss).

ii. Komori in view of Merz

In the outstanding Office Action, the Examiner admits that Komori does not expressly disclose one or more standard color bars that extend along a portion of an edge of the sheet of paper and are significantly closer in proximity to the edge of the sheet of paper than an opposing edge of the sheet of paper. Instead, the Examiner asserts that Merz teaches such a color bar, and that it would have been obvious to add the edge-located color bar in Merz to the sheet in Komori. Applicant respectfully traverses this combination rejection.

First, as discussed above, Merz does not disclose a color bar, and thus Merz cannot be used to provide the motivation to place a color bar at an edge of the sheet in Komori.

Second, Merz is fundamentally incompatible with Komori since Merz is a transparency having a colored stripe 44 with transparent voids, whereas Komori's proofing print 4 is inherently non-transparent. Thus, there is no physical way to add Merz's colored stripe 44 to the sheet in Komori because the colored stripe 44 requires transparent voids which would inherently not exist in Komori. Stated another way, if the colored stripe 44 was added to Komori, it could not function in its intended manner since there would be no transparent voids to form a code.

Third, even if the colored stripe 44 in Merz could arguably be considered to be a color bar (a position that Applicant strongly disagrees with), there would be no reason to add another color bar to Komori because the existing color chart (bar) in Figs. 12 and 13 of Komori works fine for its intended purpose, and the additional color bar may confuse the apparatus in Komori that reads the color bars. As discussed above, it would also be contrary to conventional practice in the printing arts to move the color bar in Figs. 12 and 13 of Komori to an edge of the printing product since it would result in a less ideal use of the color bar for color management of the printing press.

iii. Comments regarding Examiner's "Response to Arguments"

On page 3, first paragraph of the outstanding Office Action, the Examiner responds to Applicant's argument that the embodiments in Figs. 2, 3 and 8 of Komori disclose printing the color chart (bar) on a margin portion simultaneously with the patterns (proofing content) by stating that "Komori does not disclose simultaneous printing of content" and that a "text search with the specification [of Komori] does not reveal the term "simultaneous."

In response, the Examiner's rejection was based upon the embodiment in Fig. 13 of Komori, not the embodiments in Figs. 2, 3 and 8. Both the Applicant and Examiner agree that Fig. 13 of Komori discloses printing the color chart (bar) in approximately the center, without any patterns (proofing content). Thus, the Examiner's comments regarding this issue are not relevant to the outstanding rejection.

Furthermore, an artisan in the printing arts would clearly understand that the embodiments in Figs. 2, 3 and 8 of Komori disclose printing the color chart (bar) on a margin portion simultaneously with the patterns (proofing content) since that is the conventional technique in the printing arts when making a proof layout. The fact that Komori does not

explicitly state that this is done does not prevent Applicant from characterizing a reference in the manner that an artisan would view the reference.

In sum, the combination of Komori and Merz, as posited by the Examiner, sets forth a clearly erroneous grounds of rejection and must be withdrawn. Accordingly, the independent claims are believed to be both novel and unobvious, and thus patentable, over Komori, either taken alone, or in combination with Merz.

3. Patentability of dependent claims 10, 14, 18, 22, 26 and 30 over Komori in view of Merz

The arguments presented below are repeated from the Amendment filed February 3, 2010 since the Examiner repeated the same rationale for the as given previously for this set of claims. The Examiner did not provide any rebuttal arguments in response to these previously submitted arguments. Furthermore Merz does not make up for the deficiencies in Komori discussed below.

The Examiner is respectfully requested to withdraw this rejection if no rebuttal arguments are to be made.

Dependent claim 10 reads as follows:

10. The article of manufacture of claim 1 wherein the marginal region of the sheet of paper is a minor sized region of the sheet of paper and the blank region is a major sized region of the sheet of paper.

This feature is also disclosed in Komori. In fact, the regions identified by the Examiner in Fig. 13 of Komori as being equivalent to the claimed marginal region and blank region are exactly opposite of the claimed relationship. In Komori, the marginal region of the proofing print 4 is a major sized region of the proofing print 4 and the blank region is a minor sized region of the proofing print 4. Specifically, the size of the marginal region of the proofing print is about 25% larger than the size of the blank region of the proofing print 4, as shown in Exhibit A of this response (2,940 mm² vs. 2,352 mm²). Applicant thus respectfully traverses the Examiner's arguments in support of this rejection.

In the outstanding Office Action, the Examiner also refers to Fig. 3 as allegedly meeting claim 10. However, Fig. 3 inherently cannot meet claim 10 because it lacks the combination of elements (i) and (iii) identified above, namely, (i) a blank region for subsequent printing of a

content image portion, and (iii) that the blank region and the marginal region constitute the entire surface area of one side of the sheet of paper. Claim 10 is dependent upon claim 1, and thus claim 10 incorporates such elements. Accordingly, Fig. 3 of Komori cannot anticipate claim 10 because the patterns (proofing content) in Fig. 3 precludes Komori from having a blank region as recited in claim 1.

Dependent claims 14, 18, 22, 26 and 30 are believed to be patentable for the same reasons as applied to claim 10.

4. Patentability of remaining dependent claims over Komori in view of Merz and Komori in view of Merz and Chalmers

These dependent claims are believed to be patentable over Komori in view of Merz and Komori in view of Merz and Chalmers for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps. Furthermore, Chalmers does not make up for any of the above-noted deficiencies in Komari and Merz.

35 U.S.C. § 101 rejection

Claims 1, 12, 16, 20, 24 and 28⁴ were rejected as allegedly being directed to non-statutory subject matter. The Examiner quotes MPEP 706.03(a) and then provides the following rationale (underlining added for emphasis):

A user of the instant application is comparing a first color bar with a subsequently printed color bar to see if there is a visual color match...A set of colors is printed on a sheet of paper (figure 2A); another set of colors is printed on the same said sheet (figure 2B). Examiner reads the pre-printed color bar as a "mere arrangement of printed matter" and thus rejects the claims as not being within the statutory classes.

Applicant respectfully traverses this rejection for at least the following reasons.

⁴ Applicant presumes that all of the pending claims were meant to be rejected, even though the Office Action only lists the independent claims.

First, the Examiner's rationale does not refer to the claimed invention, but appears to be referring to the method claims in the issued parent U.S. Patent No. 6,721,068 ("068 patent"). No comparing occurs in the presently claimed invention. Nor are two color printing steps recited. Instead, the presently claimed invention recites an article of manufacture. While the presently claimed article of manufacture is used in the method claims of the '068 patent, this fact does not statutorily preclude Applicant from attempting to separately patent the article of manufacture used in this process. That is, the use of the claimed invention is not relevant to a determination of the statutory nature of the article of manufacture claims.

Second, the rationale that the pre-printed color bar is a "mere arrangement of printed matter," as discussed in MPEP 706.03(a), was presented in prior Office Actions. Applicant repeats a revised version of the same response given previously.

1. The amended claims recite an article of manufacture for use in a proofing process which is one of the statutory categories of subject matter encompassed under 35 U.S.C. § 101.⁵
2. The printed matter doctrine is a judicially-created doctrine that the USPTO has used to deny patentability to inventions directed to printed lines, characters, words, and digits that are contained on a medium and readable by humans. The presently claimed invention does not have any of these properties. While the claimed color bars are printed on the sheet of paper, they are not "printed matter" in that they are not meant to be read like one would read words, numbers or symbols to extract a meaning.
3. Each of the one or more claimed standard color bars have "a plurality of color blocks, each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space." Applicant has thus clearly claimed structural features of the article of manufacture.

⁵ 35 U.S.C. 101 Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The claimed color bars are no different in nature than visual targets on an eye test chart apparatus. See, for example, U.S. Patent No. 7,357,508 (Suzuki), which claims an eye test chart apparatus comprising visual targets. The front page and claim 1 of Suzuki is attached hereto as Exhibit B. Suzuki was rejected under 35 U.S.C. § 101 but was subsequently allowed after the claims were amended to recite an eye chart apparatus which was argued to be one of the statutory categories of subject matter encompassed under 35 U.S.C. § 101. Here, Applicant believes that an “article of manufacture” better characterizes the appropriate statutory category.

5. The Examiner refers to MPEP 706.03(a) which reads as follows:

MPEP 706.03(a)

A. Printed Matter

For example, a mere arrangement of printed matter, though seemingly a “manufacture,” is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). (underlining in the Examiner’s Office Action)

Applicant traverses the relevance of this MPEP excerpt because the claimed invention is not a mere arrangement of printed matter and none of the cited case law supports such a conclusion. It is Applicant’s understanding that the MPEP case law is the USPTO’s attempt to define the types of issues that arise in “printed matter” rejections and to indicate the types of inventions that are and are not non-statutory under § 101.⁶

a. **In re Jones:** Applicant’s claimed color bars are “structure” analogous to the pattern areas in *Jones*. *Jones* provides the following instructions on how to distinguish between non-statutory printed matter and printing on a surface (underlining added for emphasis):

That claim, and the others likewise, do not, in our opinion, define “printed matter” in the sense in which that term has heretofore been used to indicate various sorts of indicia whose primary purpose is the conveying of intelligence to a reader. What we find on the disk we would not

⁶ Two of the three cited cases resulted in a reversal of the § 101 rejection. However, all of the cases analyze key issues for deciding whether presented claims are statutory.

characterize as indicia or printing but as structure, albeit the “pattern areas” of claim 1 are not necessarily transparent and opaque, respectively, and might be produced by some sort of printing technique. *In re Jones*, 153 USPQ 77 at 80-81 (underlining added for emphasis)

Certainly there is no “printing” in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. *Jones* at 81 (underlining added for emphasis)

Like *Jones*, Applicant’s claimed color bars do not convey intelligence to a reader in the form of words or other symbols nor in the form of rulings as on a business form. Also, like *Jones*, Applicant’s claimed color bars are structure, even though they might be produced by some sort of printing technique.

b. In re Miller: As stated in *In re Miller*, new and unobvious functional relationships define patentable subject matter:

Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio, and in our judgment the appealed claims properly define this relationship. *In re Miller*, 164 USPQ 46 at 49 (underlining added for emphasis)

Applicant’s claimed color bars define a new and unobvious functional relationship between color bars pre-printed on one region of proofing paper in relation to another region of the proofing paper. For the claimed article of manufacture to serve the function of being used in a proofing process, the claimed color bars must be located in the specified region of the sheet of paper. Applicant is not claiming any article of manufacture having color bars thereon.

There are no principles in *Miller* that can support the § 101 rejection. In fact, no § 101 rejection was even given in *Miller*.

c. Ex parte Gwinn:

Gwinn claimed a set of dice for use in a “parlor golf game.” Each die represented a type of stroke (tee, fairway, putt) and had suitable marked faces for the number of strokes to be

determined in accordance with the rules of the game. The claims were found to be unpatentable over prior art dice. However, Gwinn is clearly distinguishable from the presently claimed invention because in *Gwinn*, the dots on the dice are “symbols intended to convey intelligence” (see quotation from *In re Jones* above), whereas Applicant’s claimed color bars are “structure” analogous to the pattern areas in *Jones*. While the claimed color bars are printed on the sheet of paper, they are not “printed matter” in that they are not meant to be read like one would read the face of a die to extract a meaning (here, the number of strokes).

There are no principles in *Gwinn* that can support the § 101 rejection.

While the Examiner has highlighted MPEP 706.03(a), there is simply nothing in this section or any of its cited cases to support a § 101 rejection of the pending claims. Stated simply, none of the cited cases present any fact pattern or holding that is applicable to Applicant’s claimed invention or that supports a conclusion that the claims recite a “a mere arrangement of printed matter.”

6. Applicant’s claimed color bars define a new and unobvious functional relationship between color bars pre-printed on one region of proofing paper in relation to another region of the proofing paper. For the claimed article of manufacture to serve the function of being used in a proofing process, the claimed color bars must be located in the specified region of the sheet of paper. Applicant is not merely claiming any article of manufacture having color bars thereon.

Since there is a novel and unobvious functional relationship between the printed matter (color bars) and the substrate (sheet of paper) which is required for patentability, then the Examiner must give patentable weight to the content of the printed matter (color bars).

In sum, the Examiner’s revised rationale for the § 101 rejection is clearly erroneous, and thus withdrawal of § 101 rejection is respectfully requested.

Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Withdrawal of the outstanding rejections and issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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(Date)

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